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**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	10/687,778	
	Filing Date	10/16/2003	
	First Named Inventor	Brett J. Diffley	
	Art Unit	3712	
	Examiner Name	Urszula M. Cegielnik	
Total Number of Pages in This Submission	6	Attorney Docket Number	

**ENCLOSURES (Check all that apply)**

<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please Identify below): Return Receipt Postcard
<b>Remarks</b>		

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm or Individual name	Delbert J. Barnard, Esq.		
Signature			
Date	6/16/2004		

**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
Typed or printed name	Delbert J. Barnard, Esq.		
Signature		Date	6/16/2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ ) 0

## Complete if Known

Application Number	10/687,778
Filing Date	10/16/2003
First Named Inventor	Brett J. Diffley
Examiner Name	Urszula M. Cegielnik
Art Unit	3712
Attorney Docket No.	

## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☐ Deposit Account:

Deposit  
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02-0915

Barnard & Pauly, P.S.

The Director is authorized to: (check all that apply)

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☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$ ) 0

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

		Extra Claims	Fee from below	Fee Paid
Total Claims		-20** =	X	
Independent Claims		-3** =	X	
Multiple Dependent				

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$ ) 0

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) \_\_\_\_\_

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ ) 0

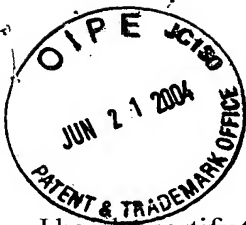
## SUBMITTED BY

Name (Print/Type)	Delbert J. Barnard, Esq.	Registration No. (Attorney/Agent)	20515	Telephone	206-381-3100
Signature	<i>Delbert J. Barnard</i>	Date	10/16/2004		

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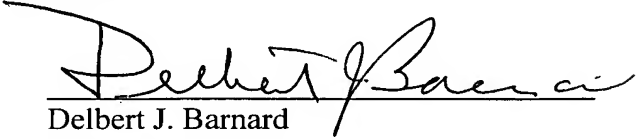
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PATENT APPLICATION

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 16, 2004.

June 16, 2004

  
Delbert J. Barnard  
Registration No. 20,515

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit: 3712  
Examiner: Urszula M. Cegielnik  
Applicant: Brett J. Diffley  
Serial No.: 10/687,778  
Filed: October 16, 2003  
For: FLOATING WATER TOY  
Date: June 16, 2004

**SUPPLEMENTAL RESPONSE**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This will supplement the Response that was filed on June 1, 2004.

Enclosed herewith is a copy of a page from *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 1 USPQ2d at 1088. Please note the underlined material on this page. In particular, note:

It is undisputed that the claims require that one desiring to build and use a travel chair must measure the space between the selected automobile's doorframe and its seat and then dimension the front legs of the travel chair so they will fit in that particular space in that particular automobile.

\* \* \*

The claims were intended to cover the use of the invention with various types of automobiles. That a particular chain on which the claims read may fit within some automobiles and not others is of no moment. The phrase "so dimensioned" is as accurate as the subject matter permits, automobiles being of various sizes.

\* \* \*

As long as those of ordinary skill in the art realized that the dimensions could be easily obtained, §112, 2d ¶ requires nothing more. The patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims.

Here, the language in the claims is "said bottom opening and said cavity being sufficiently large to receive the head of a person." Quite clearly, a person of ordinary skill in the art could arrive at a dimension that will allow the invention to be used with most if not all head sizes. In any event, those of ordinary skill in the art will realize that the appropriate dimensions can be easily obtained.

Again, it is submitted that all of the claims in this application are patentable. Early reconsideration and allowance of the application are requested.

Respectfully submitted,

BRETT J. DIFFLEY

By: 

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Registration No. 20,515  
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DJB/ct  
Enclosure

ing evidence that the '867 patent was invalid because of claim language that does not particularly point out and distinctly claim the invention. 35 U.S.C. §112, 2d ¶. The district court determined otherwise and granted Safety's motion for JNOV.

Claim 1, from which the rest of the claims depend, contains the limitation: "wherein said front leg portion is *so dimensioned* as to be insertable through the space between the doorframe of an automobile and one of the seats thereof."

Noting the testimony of Orthokinetics' expert, Mr. Hobbs, who said the dimensions of the front legs depend upon the automobile the chair is designed to suit, the district court stated:

In response to this testimony, which clearly and convincingly establishes that claim 1 of the ['867] patent does not describe the invention in "full, clear, concise and exact terms," Orthokinetics points only to the conclusory statements of Hobbs, Gaffney and expert witness William McCoy, Jr., that the patent is, in fact definite. These conclusory statements are not an adequate basis for the jury to reject Safety's defense. The undisputed, specific testimony of Gaffney and Hobbs demonstrates that an individual desiring to build a non-infringing travel chair cannot tell whether that chair violates the ['867] patent until he constructs a model and tests the model on vehicles ranging from a Honda Civic to a Lincoln Continental to a Checker cab. Without those cars, "so dimensioned" is without meaning.

[2] The foregoing statement employs two measures impermissible in law: (1) it requires that claim 1 "describe" the invention, which is the role of the disclosure portion of the specification, not the role of the claims; and (2) it applied the "full, clear, concise, and exact" requirement of the *first* paragraph of §112 to the claim, when that paragraph applies only to the disclosure portion of the specification, not to the claims. *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 453, 227 USPQ 293, 297 (Fed. Cir. 1985). The district court spoke, inappropriately, of indefiniteness of the "patent," and did not review the *claim* for *indefiniteness* under the *second* paragraph of §112.

A decision on whether a claim is invalid under §112, 1d ¶, requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification. *Seattle Box Co. v. Industrial Crating & Packing Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984); *In re Morasi*, 710 F.2d 799, 803, 218 USPQ 289, 292 (Fed. Cir. 1983).

It is undisputed that the claims require that one desiring to build and use a travel chair must measure the space between the selected automobile's doorframe and its seat and then dimension the front legs of the travel chair so they will fit in that particular space in that particular automobile. Orthokinetics' witnesses, who were skilled in the art, testified that such a task is evident from the specification and that one of ordinary skill in the art would easily have been able to determine the appropriate dimensions. The jury had the right to credit that testimony and no reason exists for the district court to have simply discounted that testimony as "conclusory".

The claims were intended to cover the use of the invention with various types of automobiles. That a particular chair on which the claims read may fit within some automobiles and not others is of no moment. The phrase "so dimensioned" is as accurate as the subject matter permits, automobiles being of various sizes. See *Rosemont, Inc. v. Beckman Instruments, Inc.*, 727 F.2d 1540, 1547, 221 USPQ 1, 7 (Fed. Cir. 1984). As long as those of ordinary skill in the art realized that the dimensions could be easily obtained, §112, 2d ¶ requires nothing more. The patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims.

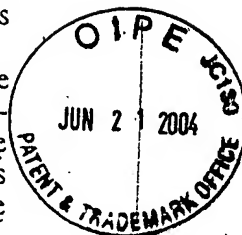
Compliance with the second paragraph of §112 is generally a question of law. *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F.2d 613, 619, 225 USPQ 634, 636 (Fed. Cir.), cert. dismissed, 106 S.Ct. 340 (1985). On the record before us, we observe no failure of compliance with the statute, and thus no basis on §112 grounds for disturbing the jury's verdict. The district court's grant of Safety's motion for JNOV for claim indefiniteness was in error and must be reversed.

#### (ii) Obviousness

The jury made numerous findings (question Nos. 39-48) all in support of its conclusion that Safety failed to prove by clear and convincing evidence that the inventions set forth in claims 1-5 of the '867 patent would have been obvious when they were made in view of the prior art to one of ordinary skill in the art.

Having outlined the prosecution history of the '867 reissue patent, the district court stated:

Analysis begins with Gaffney's concession to the [U.S. Patent and Trademark Office] that [U.S. Patent No. 1,693,633 issued to Sarah Allen (Allen)] fully anticipated the original Gaffney patent, render-



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